## REMARKS

Applicant appreciates that remailing of the Office Action of November 14, 2002 and the restarting of the period for reply based on the incomplete mailing initially sent.

Applicant appreciates the thorough review of the specification and drawings provided by the Patent Office in the present application wherein several typographical errors were located. Applicant herein corrects these errors. Specifically, Applicant fills in the serial number and corrects the filing date of the related application, provides the patent number for the second incorporated application, and changes the references to the second incorporated application to reference the patent number. Applicant further amends the specification to recite explicitly elements 30, 414, and 416 which were illustrated in the drawings, but not explicitly recited in the specification. Applicant further corrects "268" on page 15, line 3 to "368" as requested. No new matter has been added by these amendments. The specification is merely corrected to conform to the drawings or to provide information not available at the time of filing. Applicant requests withdrawal of the objections to the drawings and the specification at this time.

The Patent Office then objected to claim 13 as being improperly dependent on claim 12. Applicant respectfully traverses this objection. Claim 12 recites "sending an individual equipped with a portable computing device . . ." with no reference as to how the individual acquired the portable computing device. Claim 13 further limits claim 12 by reciting that the entity performing the method provides the portable computing device to the individual. Thus, the dependent claim 13 is narrower than claim 12 because it forecloses other routes by which the individual may acquire the portable computing device. Based on this understanding of the claim, Applicant requests withdrawal of the objection to claim 13 at this time.

### Provisional Double Patenting Rejection

Applicant acknowledges the provisional double patenting rejection. If and when this rejection is made formally, Applicant may file a terminal disclaimer at that time. Alternatively, the claims of the co-pending application may be incorporated into the present application or arguments presented as to why this is not an obviousness type double patenting situation.

## Rejection of Claim 16 Under 35 U.S.C. § 112

The Patent Office rejected claim 16 under 35 U.S.C. § 112 for lacking antecedent basis for the term "database." Applicant respectfully disagrees because, as the Patent Office points out, there is a database recited in the preamble of the underlying independent claim. However, to expedite prosecution, Applicant herein amends claim 16 to recite explicitly the step of generating the database from the plurality of records, thereby providing more complete antecedent basis for the term "database." Applicant requests withdrawal of the § 112 rejection at this time.


## Rejection of Claims 1-7, 10-16, 27, and 29-38 Under 35 § U.S.C. 103 -
## Kirouac et al. and Finley et al.

Claims 1-7, 10-16, 27, and 29-38 were rejected under 35 U.S.C. § 103 as being unpatentable over Kirouac et al. in view of Finley et al. Applicant respectfully traverses. For the Patent Office to establish *prima facie* obviousness, the Patent Office must show where in the combination each and every claim element is located. MPEP § 2143.03. Further, merely because a combination is possible does not establish *prima facie* obviousness. MPEP § 2143.01.

Claim 1 recites downloading a software upgrade to a portable computing device; accessing a computer at a remote location with the portable computing device; and uploading the software upgrade to the computer at a remote location. The Patent Office opines that Kirouac et al. teaches downloading a software upgrade from a corporate computer to a computer at a remote location and that Finley et al. teaches accessing a remote computer using a portable computing device for the purposes of diagnostics and setup.

Without conceding whether these statements are correct, Applicant notes that this still leaves the actual claim elements untaught - namely, there is no teaching or suggestion to download an upgrade to a portable computer and use the portable computer to upload the upgrade to the remote computer. A straight combination of the references shows a central computer connected to a remote computer that downloads upgrades therebetween and a selectively attachable laptop that runs diagnostics and setup routines on the remote computer. This is not what is claimed. The Patent Office appears to acknowledge this deficiency when it states "to modify the method of Kirouac to include a portable computing device to transfer upgrades to the remote computer as per the teachings of Finley." However, the motivation to modify the combination is not compelling and does not result in the claimed invention.

Specifically, the Patent Office opines that the motivation "allow[s] on-site access to the remote computer through a technician's portable interface." Merely having access does not teach or suggest performing the upgrade with the portable computing device, and nothing the Patent Office has said teaches or suggests such a modification.

Finley et al. by itself teaches access to a remote computer through a technician's portable interface. This does not provide a motivation to combine the references, much less a motivation to modify the combination. Further, Kirouac et al. has access to the remote computer in the first place - thus, there is no need to combine the references to get access, much less a motivation to modify the combination. The MPEP is quite clear about what is required in the motivation to combine and modify references. *See, for example,* MPEP § 2143.01. The Patent Office has advanced no reason to combine the references that is not already adequately addressed by the references individually. Even if the references were properly combinable, the combination does not result in the claimed invention as noted above. The Patent Office has advanced no reason to modify the combination to arrive at the claimed invention. Since the references in combination do not teach or suggest all of the elements of the claimed invention, the Patent Office has not established *prima facie* obviousness. Since the Patent Office has not established *prima facie* obviousness, Applicant is under no obligation to submit evidence of nonobviousness. MPEP § 2142.

Claims 2-7, 10, and 11 depend from claim 1 and are patentable at least for the same reasons that claim 1 is patentable.

The Patent Office's analysis with respect to claim 12 suffers from similar problems. Claim 12 recites sending an individual with a portable computing device to remote fueling sites, polling the devices at the remote site to secure information about hardware and software configurations and reporting this information to the corporate computer. The Patent Office indicates that Kirouac et al. polls the hardware and software at the remote site and stores records relating thereto in the corporate computer. The Patent Office then opines that it would be obvious to combine Kirouac et al. with Finley et al. on the grounds that it would allow for configuration monitoring at fueling sites that contain computer hardware and software. Kirouac et al., according to the Patent Office, already polls, therefore there is no reason to combine Kirouac et al. with Finley et al. There is no reason a corporation would send a laptop equipped individual to poll hardware and software incurring additional material and labor expenses when

they can do it all from their central facility. Thus, there is no reason to combine the references. Since it is improper to combine the references, the Patent Office has failed to show all of the claim elements and has not established *prima facie* obviousness.

Even if there were a motivation to combine the references, the combination does not show all of the elements of the claim. The Patent Office states that Finley et al. teaches performing software upgrades at a fueling site and suggests sending an individual equipped with a portable computing device to the remote fueling site. The Patent Office further states that the individual with the portable computing device uses the devices for acquiring/polling and updating information at the fueling site. The section of the reference that the Patent Office uses to support this position states in its entirety: "[one] service serial port 402 that may be used to connect to a service technician's laptop for diagnostics and setup." Applicant specifically traverses the assertion on the part of the Patent Office that this is the same as the recited "polling with said portable computing device, hardware and software at each of said remote fueling sites." Polling is not the same as setup and diagnostics. Thus, if the references are properly combinable, the combination results in a corporate computer that polls remote sites for configurations and sends a laptop-equipped individual to do diagnostics and set ups. This is not what is claimed. The Patent Office has offered no motivation to modify the combination to arrive at the claimed invention. Since there is no motivation to modify the combination to arrive at the claimed invention, the Patent Office has provided a second, independent reason why the claim is patentable over the rejection of record.

Claims 13-16 depend from claim 12 and are patentable for at least the same reasons. Applicant specifically addresses claim 15. The Patent Office's analysis of claim 15 suffers from the same flaw as claim 12 in that it assumes that the diagnostics of Finley et al. are polling. As explained above, this assertion is not true.

Claim 27 is rejected for the same reasons that claim 6 is rejected. Applicant notes that claims 6 depends from claim 1 and is patentable for the same reasons that claim 1 is patentable. Thus, claim 27 is patentable for at least the same reasons.

Claim 29 depends from claim 27 and is patentable for at least the same reasons.

Claim 30 is rejected for the same reasons that claim 7 is rejected and is thus patentable at least for the same reasons. Claim 31 depends from claim 30 and is patentable at least for the same reasons.

Claim 32 is rejected for the same reasons that claim 2 is rejected and is thus patentable at least for the same reasons. Claims 33-38 depend from claim 32 and are patentable at least for the same reasons.

Claims 8, 9, 17-26, and 28 were rejected under 35 U.S.C. § 103 as being unpatentable over Kirouac et al. in view of Finley et al. and further in view of Fisher et al. Applicant respectfully traverses. This rejection relies on the flawed combination of Kirouac et al. and Finley et al.. Nothing in Fisher et al. solves the underlying problem of the base combination and thus the claim elements are still not shown.

Applicant requests reconsideration of the rejection in light of the arguments presented herein. In the event that the arguments presented herein are not persuasive, Applicant submits herewith a declaration under 37 C.F.R. § 1.131 by William S. Johnson, Jr., inventor, showing conception prior to the filing date of Finley et al. Finley et al. was available for use under 35 U.S.C. § 103 by virtue of 35 U.S.C. § 102(e). The § 1.131 declaration removes the reference from the field of available prior art under 35 U.S.C. § 102(e). Without Finley et al., the rejections are unsupported and the claims stand in a condition for allowance.
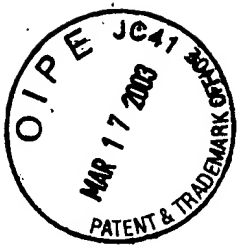
Respectfully submitted,

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**In the Specification:**

Please replace the paragraph beginning on page 1, line 5, with the following rewritten paragraph:

-- The present application is related to [concurrently filed,] commonly invented, commonly assigned application serial number [_____] 09/611,087, entitled SOFTWARE REMOTE DOWNLOAD METHOD FOR AUTOMATIC RETRIEVAL OF ROYALTY AND WARRANTY INFORMATION, which is hereby incorporated by reference.--.

Please replace the paragraph beginning on page 7, line 3, with the following rewritten paragraph:

-- Flexible delivery hose 14 is a flexible member 30 that includes the product delivery line 36 and the vapor return line 34. Both lines 34 and 36 are fluidly connected to an underground storage tank (UST) 40 through the fuel dispenser 10. UST 40 may be vented by a vent line 46 capped by a vent valve 48 as is well understood in the art. Once in the fuel dispenser 10, the liens 34 and 36 separate at split 51. Note that split 51 need not be precisely where indicated, it only need be positioned within the housing of the fuel dispenser 10. Pump 42, controlled by motor 44 extracts fuel from the UST 40 and provides it to product delivery line 36. This can be done by creating a vacuum in line 36 or other equivalent means.--.

Please replace the paragraph beginning on page 8, line 9, with the following rewritten paragraph:

-- In addition to fuel dispenser 10, other devices may exist within a fueling site 100 that likewise may require electronic control systems and software to enable those electronic control systems as better understood with reference to Figure 2. Fueling site 100 may include a primary building 102, a plurality of fueling islands 104, a car wash 106, and other outbuildings as needed or desired. Primary building 102 may include a convenience store 110, a quick serve restaurant 112, a back room 114, and other subdivisions as needed or desired. It should be appreciated that the fueling site 100 is preferably an integrated fueling site that enables purchases of a multitude of goods and services at a multitude of locations, such as that discloses in [allowed U.S. patent

9

application No. 09/ 024742, filed 17 February 1998, entitled FUEL DISPENSING SYSTEM PROVIDING CUSTOMER PREFERENCES] U.S. Patent No. 6,098,879, which is hereby incorporated by reference.--.

Please replace the paragraph beginning at page 9, line 16 with the following rewritten paragraph:

--      Reference is again made to the previously incorporated [application] '879 patent for a full description of the myriad terminals and stations within the fueling site 100.  That [application] patent also provides a nice description of the potential functions that many of the terminals and stations may perform.--.

Please replace the paragraph beginning at page 14, line 22, with the following rewritten paragraph:

--      If the problem cannot be fixed, then an error message may be generated (block 362) and the process continues to block 370 (block 364).  Once the patch has been installed, then the portable computing device 206 uploads the requested software to the site controller 150 (block 366).  Software so uploaded is transferred from the site controller 150 to the peripheral devices if appropriate (block [268] 368).  Note that the patch may be installed after the requested software in some instances if needed or desired.--.

Please replace the paragraph beginning at page 17, line 17, with the following rewritten paragraph:

--      Corporate computer 202 may also update a database containing information about the customers' present hardware and software configurations (block 414).  Specifically, the corporate computer 202 may link a location identifier with the configurations and from the configuration make recommendations on potentially desirable upgrades that may be available to a particular fueling site 100 based on what is presently installed at that location.--.

Please replace the paragraph beginning at page 17, line 22 with the following rewritten paragraph:

--Finally, the corporate computer 202 should reset counters within the portable computing device 206 to reflect that the ASC 204 has been credited for all work performed since the last access to the corporate computer 202 (block 416).  This may also be accomplished with a timestamp function as previously described.--.

**In the claims:**

Please amend claim16 as follows:

16.  (once amended) The method of claim 12 further comprising generating a database from said plurality of records and generating recommendations as to potential upgrades from said database.